



3510-16-P

## **DEPARTMENT OF COMMERCE**

### **United States Patent and Trademark Office**

#### **Patent Reexaminations**

**AGENCY:** United States Patent and Trademark Office, Commerce

**ACTION:** Proposed collection; comment request

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as part of its continuing effort to reduce paperwork and respondent burden, invites the general public and other Federal agencies to comment on proposed and/or continuing information collections, as required by the Paperwork Reduction Act of 1995, Public Law 104–13 (44 U.S.C. 3506(c)(2)(A)).

**DATES:** Written comments must be submitted on or before [***INSERT DATE 60 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER***].

**ADDRESSES:** Written comments may be submitted by any of the following methods:

- *Email:* InformationCollection@uspto.gov. Include “0651–0064 Patent Reexaminations” in the subject line of the message.
- *Mail:* Marcie Lovett, Records Management Division Director, Office of the Chief Information Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313–1450.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-7728; or by e-mail to [Raul.Tamayo@uspto.gov](mailto:Raul.Tamayo@uspto.gov) with “Paperwork” in the subject line. Additional information about this collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

## **SUPPLEMENTARY INFORMATION:**

### **I. Abstract**

The United States Patent and Trademark Office (USPTO) is required by 35 U.S.C. 131 and 151 to examine applications and, when appropriate, allow applications and issue them as patents. Chapter 30 of Title 35 U.S.C. provides that any person at any time may file a request for reexamination by the USPTO of any claim of a patent on the basis of prior art patents or printed publications. Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from

third parties. The rules outlining *ex parte* reexaminations are found at 37 CFR 1.510-1.570.

35 U.S.C. 257 permits a patent owner to request supplemental examination of a patent by the USPTO to consider, reconsider, or correct information believed to be relevant to the patent. The rules outlining supplemental examination are found at 37 CFR 1.601-1.625.

The Leahy-Smith America Invents Act terminated *inter partes* reexamination effective September 16, 2012. However, *inter partes* reexamination proceedings based on *inter partes* reexamination requests filed before September 16, 2012, continue to be prosecuted. Therefore, this collection continues to include items related to the prosecution of *inter partes* reexamination proceedings. The rules outlining *inter partes* reexaminations are found at 37 CFR 1.903-1.931.

Thus, the items included in this collection cover (i) requests for *ex parte* reexamination, (ii) requests for supplemental examination, and (iii) information that may be submitted by patent owners and third party requesters in relation to the prosecution of an *ex parte* or *inter partes* reexamination proceeding. It should be noted that the Requests for *Ex Parte* Reexamination and Supplemental Examination are distinct collections from the Request for *Ex Parte* Reexamination and Supplemental Examination Transmittal Forms, respectively. Whereas the transmittal forms are used by a requester (patent owner or third party) as a checklist to ensure compliance with the requirements of the statutes and rules for *ex parte* reexaminations and supplemental

examinations, the requests themselves represent the substantive analysis undertaken by requesters of *ex parte* reexamination and supplemental examination.

The public uses this information collection to request *ex parte* reexamination and supplemental examination, to prosecute reexamination proceedings, and to ensure that the associated documentation is submitted to the USPTO.

## **II. Method of Collection**

By mail, facsimile, hand delivery, or electronically to the USPTO.

## **III. Data**

*OMB Number:* 0651–0064.

*Form Number(s):* PTO/SB/57 and PTO/SB/59.

*Type of Review:* Renewal of an existing collection.

*Affected Public:* Individuals or households; businesses or other for-profits; and not-for-profit institutions.

*Estimated Number of Respondents:* 4,170 responses per year.

*Estimated Time Per Response:* The USPTO estimates that it will take the public from 0.30 hours (18 minutes) to 55 hours to gather the necessary information, prepare the appropriate form or other documents, and submit the information to the USPTO. The time per response, estimated annual responses, and estimated annual hour burden associated with each instrument in this information collection is shown in the table below.

*Estimated Total Annual Hour Burden:* 95,290 hours.

*Estimated Total Annual Cost Burden (Hourly):* \$37,067,810 per year. The USPTO expects that the information in this collection will be prepared by attorneys. Using the professional rate of \$389 per hour for attorneys in private firms, the USPTO estimates that the respondent cost burden for this collection will be approximately \$37,067,810 per year.

IC Number	Information Collection Instrument	Estimated time for response (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total Cost (c) x (d) = (e)
1	Request for Supplemental Examination Transmittal Form (PTO/SB/59)	18 minutes	50	15	\$389.00	\$5,835
2	Request for Supplemental Examination	25 hours	50	1,250	\$389.00	\$486,250
3	Request for <i>Ex Parte</i> Reexamination Transmittal Form (PTO/SB/57)	18 minutes	450	135	\$389.00	\$52,515
4	Request for <i>Ex Parte</i> Reexamination	55 hours	450	24,750	\$389.00	\$9,627,750
5	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	23 hours	1,250	28,750	\$389.00	\$11,183,750
6	Patent Owner's 37 CFR 1.530 Statement	8 hours	160	1,280	\$389.00	\$497,920
7	Third Party Requester's 37 CFR 1.535 Reply	8 hours	50	400	\$389.00	\$155,600
8	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	33 hours	700	23,100	\$389.00	\$8,985,900
9	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	41 hours	10	410	\$389.00	\$159,490
10	Response to Final Rejection in <i>Ex Parte</i> Reexamination	17 hours	400	6,800	\$389.00	\$2,645,200
11	Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	41 hours	100	4,100	\$389.00	\$1,594,900
12	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	41 hours	100	4,100	\$389.00	\$1,594,900

IC Number	Information Collection Instrument	Estimated time for response (a)	Estimated Annual Responses (b)	Estimated annual burden hours (a) x (b) = (c)	Rate (\$/hr) (d)	Total Cost (c) x (d) = (e)
13	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	30 minutes	400	200	\$389.00	\$77,800
<b>Total</b>	.....	.....	<b>4,170</b>	<b>95,290</b>	.....	<b>\$37,067,810</b>

*Estimated Total Annual Cost Burden (Non-Hourly):* \$929.80 per year. There are no capital start-up, recordkeeping, or maintenance costs associated with this information collection. However, this collection does have annual (non-hour) costs in the form of postage costs.

#### Postage

The USPTO expects that approximately 95 percent of the responses in this collection will be submitted electronically. Of the remaining 5 percent, the vast majority—98 percent—will be submitted by mail, for a total of 204 mailed submissions. The documentation for requests for supplemental examination and requests for *ex parte* reexamination will typically be mailed to the USPTO with the appropriate transmittal form, reducing the number of unique mailings to 180. The USPTO estimates that the average postage cost for a mailed submission will be \$0.49 cents for Petitions to Request Extension of Time and \$5.75 for all other mailed submissions. Therefore, the USPTO estimates a total postage cost of approximately \$929.80 per year.

The total non-hour respondent cost burden for this collection in the form of postage costs is approximately \$929.80 per year.

## Filing Fees

The fees in 0651-0064 were moved into collection 0651-0072 (America Invents Act Section 10 Patent Fee Adjustments). As a result, this collection no longer includes any filing or processing fees.

## **IV. Request for Comments**

Comments are invited on: (a) Whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information shall have practical utility; (b) the accuracy of the agency's estimate of the burden (including hours and cost) of the proposed collection of information, including the validity of the methodology and assumptions used; (c) ways to enhance the quality, utility, and clarity of the information to be collected; and (d) ways to minimize the burden of the collection of information on respondents, including through the use of automated collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Comments submitted in response to this notice will be summarized or included in the request for OMB approval of this information collection; they will also become a matter of public record.

Dated: March 13, 2015.

Marcie Lovett,

Records Management Division Director, USPTO,

Office of the Chief Information Officer.

**BILLING CODE 3510-16-P**

**[FR Doc. 2015-06461 Filed: 3/19/2015 08:45 am; Publication Date: 3/20/2015]**